

REMARKS

Summary of Office Action

Claims 1-61 are pending in the above-identified patent application.

The Examiner found that there are allegedly seven distinct inventions in the above-identified patent application and required restriction to one of those inventions, as follows:

Group I: Claims 1-21, drawn to a "method [to] analyze data";

Group II: Claims 22-35, drawn to "an apparatus for analyzing data";

Group III: Claims 36-47, drawn to "an apparatus for data analysis";

Group IV: Claims 48-51, drawn to a "data analysis method";

Group V: Claims 52-55, drawn to "apparatus for data";

Group VI: Claims 56-59, drawn to "apparatus for instantaneous data analysis"; and

Group VII: Claims 60 and 61, drawn to "an offering method."

The Examiner also required election between two species, regardless of the invention elected -- viz., one in which the data analyzed are financial data and one in which the data are not specifically financial.

Applicant's Election

Applicant provisionally elects with traverse, for examination in this application, the invention of Group I (claims 1-21), and the species in which the data to be analyzed are financial data.

Traversal of the Restriction Requirement

Applicant respectfully traverses the restriction requirement.

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According to the Guidelines for restriction set forth in MPEP § 803, "Examiners must provide reasons and/or examples to support conclusions" of restriction. Moreover, "[s]ince requirements for restriction under 35 U.S.C. § 121 are discretionary with the Commissioner, it becomes very important that practice under this section be carefully administered" (MPEP § 803.01). Applicant respectfully submits that the current restriction requirement is based on conclusory statements that are not supported by reasons, and are not the result of "careful administ[rati]on."

Specifically, the Examiner states conclusorily that the seven identified inventions are distinct because they are unrelated. Citing MPEP §§ 806.04 and 808.01, the Examiner states that "[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects." The Examiner concludes that "[i]n the instant case the different inventions have different modes of operation," but makes no attempt to explain what the "modes" of operation are or how they are different.

In addition, the test set forth by the Examiner for "unrelatedness" requires not only that the allegedly distinct inventions have different modes of operation, but also that they not be disclosed as capable of use together. The two prongs of the test are connected by "and," not by "or," and therefore both prongs must be satisfied before the inventions can be considered unrelated. In this case, the various method claims (with the possible exception of claims 60 and 61) are merely definitions of different scope, while the apparatus claims define corresponding apparatus for carrying out the method. Therefore, by definition the allegedly distinct inventions are capable of use together, and that prong of the test fails. Therefore, the inventions are not unrelated.

More significantly, this test for unrelatedness is set forth in Patent Examining Form Paragraph 8.20.02, which

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accompanies MPEP § 808.01, directed to independent inventions. The Examiner has not alleged that the inventions are independent, but merely distinct. Accordingly, the test is irrelevant. In this case, the inventions clearly are not independent (MPEP § 806.04). The instructions for Patent Examining Form Paragraph 8.20.02 give, as an example of unrelated inventions, "a necktie and a locomotive bearing." The allegedly distinct inventions do not rise to anywhere near that level of unrelatedness. Indeed, the allegedly distinct inventions relate to the same general inventive concept.\*

The Examiner also relies on allegedly different classifications of the allegedly different inventions to support the restriction requirement. However, according to the classifications set forth by the Examiner, method inventions I and VII, and apparatus invention V, have the same classification. Similarly, apparatus inventions II, III and VI have the same classification. Thus, the classifications do not justify a seven-way restriction of this application.

Applicant respectfully submits that there is no justification for identifying each independent claim as a separate invention. It is axiomatic that an applicant is entitled to various independent claims of different scope. That does not make each independent claim a separate invention. In this case, there are various independent method claims of different scope and various independent claims of different scope directed to apparatus for carrying out the method. At most, this justifies a restriction between method claims and apparatus claims. However, at least some of the independent apparatus claims are presented in means-plus-function form. According to MPEP § 806.05(e), governing claims to a method and apparatus for carrying out

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\* Applicant notes that when acting as an International Search Examiner for applicant's counterpart international patent application, the Examiner did not find lack of unity among claims 1-61.


the method, such means-plus-function claims link the method and apparatus. Accordingly, even a method vs. apparatus restriction would not be proper in this application.

For these reasons, applicant respectfully submits that the restriction requirement should be withdrawn.

Conclusion

An early and favorable action, withdrawing the restriction requirement and addressing the claims on their merits, is respectfully requested.

Respectfully submitted,

  
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